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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,468	11/09/2001	Ranjith Divigalpitiya	55525US011	5982

32692 7590 08/20/2003

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EXAMINER

LE, HOA T

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 08/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

10/008,468

Applicant(s)

RANJITH ET AL

Examiner

H. T. Le

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 1-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,9,11.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election of claims 31-37 in Paper No. 8 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Accordingly, claims 1-30 are withdrawn from further consideration as being drawn to a nonelected invention.

### *Claim Rejections - 35 USC § 112*

2. Claims 31-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 31, it is unclear how "bristles" in the step "passing bristles of a brush" relate to the claimed method of dispensing particles. No bristles have been used in dispensing particles. Further, it is unclear how and/or from where the bristles are being passed on the screen. Last line, "the surface" has no antecedent basis. In addition, it is unclear how the particles embedded on the web. No web is being used in the claimed method steps.

Claims 32-37 are deemed indefinite in view of their dependency upon claim 31.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 31-33, 36 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Jin et al (US 4,737,112).

Claim 31: Jin et al disclose a composite layer medium comprising a thin layer and particles embedded in the film. See col. 4, lines 30-41. Web is defined in the instant specification as “film or tape” (see instant specification, page 1, line 15). A thin layer is a “film”. Thus the thin layer as disclosed in the Jin reference satisfies the claimed “web”. The method of dispensing particles disclosed by Jin is not the same as the method recited in the instant claims; however, the instant claims are in product-by-process claim format, thus only product limitations are taken into consideration. In this case, the method taught by Jin results in web containing embedded particles as claimed.

Claims 32, 33, 36 and 37: col. 4, lines 1-11.

5. Claims 31-33, 36 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Calhoun et al (US 5,240,761).

Claim 31: Calhoun et al disclose an adhesive tape containing embedded particles. See col. 2, lines 30-40 and col. 3, lines 7-11. Web is defined in the instant specification as “film or tape” (see instant specification, page 1, line 15). Thus the tape as disclosed in the Calhoun reference satisfies the claimed “web”. The method of dispensing particles disclosed by Calhoun is not the same as the method recited in the instant claims; however, the instant claims are in product-by-process claim format, thus only product limitations are taken into

consideration. In this case, the method taught by Calhoun results in web containing embedded particles as claimed.

Claims 32, 33, 36 and 37: col. 2, lines 39-40 and col. 5, lines 40-44 and 47-60.

6. Other references are cited as art of interest.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to H. T. Le whose telephone number is 703-308-2415. The examiner can normally be reached on 10:00 a.m. to 6:30 p.m., Mondays to Friday.

A handwritten signature in black ink, appearing to read 'H. T. Le', is positioned above the printed name and title.

H. T. Le  
Primary Examiner  
Art Unit 1773

hl  
August 11, 2003